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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/631,540	08/03/00	IMANAKA R	MAT-3720US2

EXAMINER	
GRANT, C	
ART UNIT	**PAPER NUMBER**
2611	10

DATE MAILED: 06/27/01

023122
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P O BOX 980
VALLEY FORGE PA 19482

TM02/0627

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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1- File Copy

Office Action Summary

Application No.	Applicant(s)
09/631,540	Imanaka
Examiner	**Art Unit**
Christopher Grant	2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Apr 19, 2001* .

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *14-24* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☒ Claim(s) *16-21* is/are allowed.

6) ☒ Claim(s) *14 and 22* is/are rejected.

7) ☒ Claim(s) *15, 23, and 24* is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 9

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

DETAILED ACTION

Reissue Applications

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 14 and 22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14, 17 and 18 of co-pending Application No. 09/594,152. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are different definitions or descriptions of the same subject matter, varying in breadth. For example:

a) the claimed "*an information receiver....on a recording medium*" (lines 1-4) of the current application claim 14 corresponds to the "*recording medium used for an information on demand system*" (lines 1-3) of the '152 co-pending application claim 17;

b) the claimed "*recording said information on a recording medium*" (lines 3-4) of the current application claim 14 corresponds to the "*recording reproducing apparatus for recording the information into a recording medium*" (lines 7-9) of the '152 co-pending application claim 17;

c) the claimed "*said information charged differently....*" (lines 5-8) of the current application claim 14 corresponds to the "*charging means for charging a different amount....*" (lines 10-14) of of the '152 co-pending application claim 17; and

d) the claimed "*said recording medium evaluated to determine ....includes an identifier prior to permitting....*" (lines 9-13) of the current application claim 14 corresponds to the "*wherein a unique identification (ID) information is detected.....*" (lines 15-19) of the '152 co-pending application claim 17.

Therefore, it would have been obvious to one of ordinary skill in the art to readily recognize that the conflicting claims are different definitions or descriptions of the same subject matter varying in breadth.

The limitations recited in current application claim 14 corresponds to the limitations recited in the '152 co-pending application claim 14.

The limitations recited in current application claim 22 corresponds to the limitations recited in the '152 co-pending application claim 18.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 14 and 22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-16 of co-pending Application No. 09/631,542. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are different definitions or descriptions of the same subject matter, varying in breadth. For example:

a) the claimed "*An information receiver ...recording said information on a recording medium*" (lines 1-4) of current application claim 14 corresponds to "*A recording medium for recording information...*" (lines 1-3) of the '542 co-pending application claim 14;

b) the claimed "*said information charged differently depending....*" (lines 5-8) of current application claim 14 corresponds to "*wherein recording of said information...effects charges for said information...*" (lines 8-10) of the '542 co-pending application claim 14; and

c) the claimed "*said recording medium evaluated ....includes an identifier prior to permitting recording....*" (lines 9-13) of current application claim 14 corresponds to the "*an identifier,*

wherein said information is recorded...based on a presence of said identifier"." (lines 4-7) of the '542 co-pending application claim 14.

Therefore, it would have been obvious to one of ordinary skill in the art to readily recognize that the conflicting claims are different definitions or descriptions of the same subject matter varying in breadth.

The limitations recited in current application claim 14 also corresponds to the limitations recited in the '542 co-pending application claim 15.

The limitations recited in current application claim 22 corresponds to the limitations recited in the '542 co-pending application claim 16.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Note to applicant

4. Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.173.

Allowable Subject Matter

5. Claims 16-21 would be allowable because the prior art fails to disclose or suggest an information receiver comprising a receiving means, recording means for recording at least a portion of the information onto a recording medium, said information charged differently depending upon whether or not said information is recorded on the recording medium and verification means for verifying that the recording medium includes an identifier prior to permit recording of the information as recited in the claims.

6. Claims 15 and 23-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

7. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872 9314 (for formal communications intended for entry and for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris Grant whose telephone number is (703) 305-4755. The examiner can normally be reached on Monday-Friday from 8:00am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile, can be reached on (703) 305-4380.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305 4700.

Christopher Grant

Christopher Grant
Primary Examiner
June 26, 2001